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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/623,584	12/04/2000	Horst Grafe	HM-349 PCT	5053

7590 07/01/2003

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[REDACTED] EXAMINER

ASHLEY, BOYER DOLINGER

ART UNIT	PAPER NUMBER
3724	[REDACTED]

DATE MAILED: 07/01/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/623,584	GRAFE ET AL.
	Examiner	Art Unit
	Boyer D. Ashley	3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 04 April 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 14-28 is/are pending in the application.
- 4a) Of the above claim(s) 22-26 and 28 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 14-21 and 27 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to applicant's amendment filed 4/11/03, wherein claim 14 was amended.

Claim Objections

2. Claim 18 objected to because of the following informalities: It appears that the phrase "the drive is" should be "the drives are". How could you only have one drive after setting forth at least two drives. Appropriate correction is required.
3. The claims are objected to because they lack a proper introduction. The present Office practice is to insist that each claim must be the object of a sentence stating with "I (or we) claim", "The invention claimed is", or the equivalent. M.P.E.P. § 608.01(m). Appropriate correction is required.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 14-16, 18-19 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Foreign Document 2718793, hereinafter FD '793.

FD '793 discloses the same invention as claimed as set forth in paragraph 13 of paper number 9 and as further explained here. Moreover, as the previous reaction stated the above is only one example, the FD'793 can anticipate other interpretations of the claims by using element 36 as one of the drives. Therefore, drive 36 effects, or influences, the cutting movements by adjusting for the thickness of the workpiece while drive 49 effects the support elements (the piston and link 48) for the rockers (45/47), wherein the support elements are shortenable (for example, the support element, i.e.

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the piston has a length that is adjustable in and out of the drive 49 while support element, i.e. link 48) is has a length that is adjustable by rotating in and out of vertical alignment with link 47).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over FD '793 as set forth in paragraph 15 of paper number 9.

7. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over FD '793 as set forth in paragraph 16 of paper number 9.

Response to Arguments

8. Applicant's arguments filed 4/11/03 have been fully considered but they are not persuasive.

Applicant contends that the relied upon German reference only discloses a single drive through which cutting movement is carried out. Although, it is true that the German reference only discloses one drive for a cutting movement, it does however, discloses multiple drives. For example, as asserted above, adjustment element 36 acts like a drive to adjust the upper drum relative to the lower drum. Therefore, the German reference does indeed have two drives. It should be noted that instant application

claims and disclosure only require one drive for effecting a cutting movement and other for adjusting the rocker, presumably for adjustments in work thickness.

Applicant's comments regard the intended speed of operation of the instant device are noted, however, such intended use does not serve to distinguish the claimed invention from the prior art when the prior art satisfies all structure elements.

9. For the reasons above, the grounds of rejection are deemed proper.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Boyer Ashley whose telephone number is 703-308-1845. The examiner can normally be reached on Monday thru Thursday between 7:30am and 6:00pm. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 703-308-1082.

In lieu of mailing, it is encouraged that all formal responses be faxed to 703-872-9302. Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is 703-308-1148.



**Boyer D. Ashley
Primary Examiner
Art Unit 3724**

bda
June 23, 2003